

Serial No. 09/498234

Amendment dated January 8, 2004

Response to Office Action dated October 9, 2003

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REMARKS/ARGUMENTS

Claims 1, 2, 4-8, 15, and 18-21 were pending and examined. The Examiner rejected claims 1, 2, 4-6, 15, and 18-21 under 35 USC § 103(a) as unpatentable over Wilcox (US Patent No. 5,199,077) in view of Beigi (US Patent No. 6,345,262 B1) in further view of Lee (US Patent No. 6,067,520). The Examiner further rejected claims 7 and 8 under 35 USC § 103(a) as unpatentable over Wilcox in view of Lee as applied to claim 1¹ and further in view of well known prior art.

Claim rejections under 35 USC § 103(a)

The Examiner rejected independent claims 1 and 15 under 35 USC § 103(a) as unpatentable over Wilcox in view of Beigi and Lee. In response, Applicant would respectfully request the Examiner to withdraw Beigi as a prior art reference. Because Beigi qualifies as prior art under Section 102(e) only and because the subject matter of Beigi and the claimed invention were, at the time of invention, owned by or subject to an obligation of assignment to a common entity, namely, IBM Corporation, a Section 103(a) rejection based on a combination of references that includes Beigi is improper under Section 103(c) as amended November 29, 1999. Accordingly, Applicant would respectfully request the Examiner to withdraw Beigi as a reference and to withdraw the Section 103(a) rejections of independent claims 1 and 15 and all claims depending therefrom (i.e., all pending claims in the application).²

In the present response, Applicant has responded to the Examiner's rejection of the pending claims under 35 USC § 103(a), which is the only issue remaining in the Application. Accordingly, Applicant believes that this response constitutes a complete response to the issues raised in the office action. In light the accompanying remarks, Applicant believes that the pending claims are in condition for allowance. Accordingly, Applicant would request the

¹ As dependent claims, claims 7 and 8 include all of the limitations of claim 1. Because the Section 103(a) rejection of claim 1 was based on a combination of Wilcox, Beigi, and Lee, Applicant believes that the rejection of claims 7 and 8 was intended to be based upon the same combination of references even though the detailed action only explicitly refers to Wilcox and Lee.

² If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. MPEP 2143.03 citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

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Examiner to withdraw the rejections, allow the pending claims, and advance the application to issue. If the Examiner has any questions, comments, or suggestions, the undersigned attorney would welcome and encourage a telephone conference at 512.428.9872.

Respectfully submitted,



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